

21



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,895	03/08/2002	Hiroshi Sukegawa	220515US2S	2724

22850 7590 04/04/2006

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

RHODE JR, ROBERT E

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/092,895	Applicant(s) SUKEGAWA, HIROSHI	
	Examiner Rob Rhode	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3 - 5 and 47 - 50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3 - 5 and 47 - 50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1-18-06 has been entered.

Response to Amendment

Applicant amendment of 1-18-06 amended claims 1 and 5 well as canceled claim 2 and traversed rejections of Claims 1, 3 – 5 and 47 - 50.

Currently, claims 1, 3 - 5 and 47 - 50 are pending.

Information Disclosure Statement

The information disclosure statement filed 3-08-02 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3 – 5 and 47 – 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spagna (US 6,587,837 B1) in view of Ginter (US 5,892,900).

Regarding Claim 1 (Currently Amended), Spagna teaches a music distribution method comprising:

receiving by a server a request to distribute music information from a music reproduction apparatus through a communication medium (see at least Abstract, Col 2, lines 58 – 64, Col 28, lines 66 – 67, Col 82, lines 24 – 34 and Figures 5 – 7);

generating by said server a distribution file in which said music information requested and information concerning settings and conditions required for transmitting information from said music reproduction apparatus to said server are integrated; distributing by said server said distribution file to said music reproduction apparatus through said communication medium (see at least Col 5, lines 9 – 42 and Figure 13);

receiving by said server through said communication medium a number of times of reproduction with attribution of said music information reproduced by said music

Art Unit: 3625

reproduction apparatus (see at least Col 4, lines 26 – 32, Col 13, lines 31 – 37 and Col 23, lines 50 – 52); and

identifying a copyright holder to whom a copyright fee should be paid based on said music information reproduced by said music reproduction apparatus. and paying said copyright fee (see at least Col 10, lines 22 – 24, Col 11, lines 8 – 16 and 26 – 34, Col 15, lines 44 – 51 and Col 90, lines 38 – 40).

However, Spagna does not specifically disclose and teach a method for music distribution including registering a music reproduction apparatus specified by a listener who pays a fixed membership fee; and distributing a payment to a copyright holder who holds a copyright of said music information, in accordance with the appreciation records, the payment being drawn from the membership fee paid by the listener.

On the other and in the same area of distributing content such as music, Ginter teaches a method for music distribution including registering a music reproduction apparatus specified by a listener who pays a fixed membership fee (see at least Abstract, Col 1, lines 58 – 62, Col 2, lines 20 – 32, Col 7, lines 13 – 19, Col 179, 58 – 67, Col 140, lines 25 – 43 and 62 – 67 and Col 341, lines 19 – 23 and Figure 2); and distributing a payment to a copyright holder who holds a copyright of said music information, in accordance with the appreciation records, the payment being drawn from the membership fee paid by the listener (see at least Col 20, lines 23 – 43, Col 24, lines

Art Unit: 3625

24 – 53, Col 135, lines 44 – 52, Col 140, lines 25 – 43, Col 308, lines 1 – 24 and Col 312, lines 28 – 32).

It would have been obvious to one of ordinary skill in the art at the time to have provided the method of Spagna with the method of Ginter to have enabled a method as recited in claim 1. Spagna discloses teaches a music distribution method comprising: receiving by a server a request to distribute music information from a music reproduction apparatus through a communication medium; generating by said server a distribution file in which said music information requested and information concerning settings and conditions required for transmitting information from said music reproduction apparatus to said server are integrated; distributing by said server said distribution file to said music reproduction apparatus through said communication medium; receiving by said server through said communication medium a number of times of reproduction with attribution of said music information reproduced by said music reproduction apparatus; and identifying a copyright holder to whom a copyright fee should be paid based on said music information reproduced by said music reproduction apparatus. and paying said copyright fee (see at least Abstract, Col 2, lines 58 – 64, Col 5, lines 9 – 42, Col 11, lines 8 – 16 and Figure 13). In turn, Ginter discloses a music distribution method comprising: registering a music reproduction apparatus specified by a listener who pays a fixed membership fee; and distributing a payment to a copyright holder who holds a copyright of said music information, in accordance with the appreciation records, the payment being drawn from

the membership fee paid by the listener (see at least Abstract, Col 20, lines 23 – 43, Col 24, lines 24 – 53, Col 135, lines 44 – 52, Col 140, lines 25 – 43, Col 308, lines 1 – 24 and Col 312, lines 28 – 32 and Figure 2). Thereby, one of ordinary skill in the art would have been motivated to extend the method of Spagna with a method for music distribution comprising: registering a music reproduction apparatus specified by a listener who pays a fixed membership fee; and distributing a payment to a copyright holder who holds a copyright of said music information, in accordance with the appreciation records, the payment being drawn from the membership fee paid by the listener. In this manner, the method will accommodate several different business models, which will increase application to various solutions for distributing music and thereby too increase the potential additional revenue for this method.

Regarding Claim 3 (original), Spagna teaches a music distribution method, wherein said communication medium is the Internet (Col 25, line 36).

Regarding Claim 4 (Original), Spagna teaches a music distribution method, wherein said information concerning said settings and conditions includes an Internet IP address required for reporting said number of times of reproduction of said music information from said music reproduction apparatus to said server (Col 4, lines 22 – 23).

Regarding Claim 5 (Currently Amended), Spagna teaches a music reproduction method, wherein said server receives the appreciation records including said number of

Art Unit: 3625

times of reproduction of said music information at regular intervals (Col 4, lines 26 – 32, Col 13, lines 31 – 37 and Col 23, lines 50 – 52).

Regarding Claim 47, Spagna teaches a music reproduction method, wherein said music information distributed to said music reproduction apparatus is stored in a nonvolatile semiconductor memory in said music reproduction apparatus and Claim 48 wherein said nonvolatile semiconductor memory includes a flash memory (Col 22, line 23). Please note that Spagna does not specifically disclose nonvolatile nor flash memory. However, Spagna does disclose memory. Moreover, these types of memory were old and well known at the time of the applicant's invention. Thereby, one of ordinary skill would have been motivated to extend the memory types of Spagna with nonvolatile and flash to ensure that content is not lost, which has been saved.

Regarding Claim 49 and related claim 50, Spagna teaches a music distribution method, wherein said distribution file has a header information portion and a main body information portion arranged under said header information portion, and a structure in which said information concerning settings and conditions are recorded in said header information portion, and said music information is recorded in said main body information portion (Col 20, lines 14 – 59 and Col 29, lines 4 – 14).

Response to Arguments

Applicant's arguments with respect to claims 1, 3 – 5 and 47 - 50 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **571.272.6761**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Mark Fadok** can be reached on **571.272.6755**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

571-273-8300 [Official communications; including
After Final communications labeled
"Box AF"]

For general questions the receptionist can be reached at

571.272.3600

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Art Unit: 3625

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RER

A handwritten signature in black ink, appearing to read "R. E. Mroz", with a stylized flourish at the end.